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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,122	02/20/2007	Thomas Brinz	10191/4358	8791
26646 7590 07/01/2010 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER BENITEZ, JOSHUA				
ART UNIT 2829		PAPER NUMBER		
MAIL DATE 07/01/2010		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/582,122

**Applicant(s)**

BRINZ ET AL.

**Examiner**

JOSHUA BENITEZ

**Art Unit**

2829

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 30-32 and 34-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-32 and 34-57 is/are allowed.
- 6) ☒ Claim(s) 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Amended claims 30-32, 34-36 and 38-58 of U.S. Application No. 10/582,122 filed on 03/29/2010 are presented for examination.

### ***Drawings***

2. The drawings, more specifically figures 5 and 10, are objected to under 37 CFR 1.83(b) because they are incomplete.

37 CFR 1.83(b) reads as follows:

When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 58 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 58 is directed to both an apparatus and a process, making reference to more than one statutory class of invention. The preamble of the claim refers to the apparatus but no structural limitations while all the limitations as currently written refer to method steps. As such, the claim is neither directed to a "process" nor a "machine", but rather embrace or overlap two different statutory classes of invention. See MPEP 2173.05(p) [R-5].

The court determined in *IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (Fed. Cir. 2005) that a device claim with a method step therein is indefinite under 112(2) because it cannot be determined when the claim is infringed. Additionally, combining two separate statutory classes of invention in a single claim raises serious questions for a manufacturer or seller regarding infringement. Therefore, a claim directed to more than one different statutory class of invention is not sufficiently precise to provide competitors with an accurate determination of the "metes and bounds" of

protection involved so that an evaluation of the possibility of infringement may be ascertained with a reasonable degree of certainty, as discussed by the court in *In re Hammack*, supra (*Ex Parte Lyell*). Furthermore, in *Hewlett Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ 2d 1525, 1528 (Fed. Circ. 1990), the court held that: "Apparatus claims cover what a device is, not what a device does."

***Allowable Subject Matter***

5. Claims 30-32, 34-36 and 38-57 are allowed.
6. The following is an examiner's statement of reasons for allowance:

As for claim 30, the specific limitations of "and connected to a gas supply unit, wherein the measuring head includes a gas chamber formed by a substantially bell-shaped distributing device for applying gas to the sample plate, wherein the bell-shaped distribution device is connected to the gas supply unit" in the combination as claimed are neither anticipated nor made obvious over the prior art made of record.

Claims 31-32, 34-36 and 38-47 are also allowable for depending on claim 30.

Regarding claim 48, the specific limitations of "calculating a theoretical impedance spectrum for at least one selected material sample using the error minimization computation, based on the impedance spectrum measured for the at least one material sample and on the starting values for the components of the respective circuit equivalent; determining fit values for the components of the respective circuit equivalent; determining a validation magnitude for the calculated, theoretical impedance spectrum; and determining an evaluation variable by a comparison of at least one of the

fit values for the components of the respective circuit equivalent to a reference value" in the combination as claimed are neither anticipated nor made obvious over the prior art made of record.

Claims 49-57 are also allowable for depending on allowable claim 48.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Response to Arguments***

7. Applicant's arguments filed 03/29/2010 have been fully considered but they are not persuasive.

Applicant argues in page 7 that the Objection to the Drawings is not understood and entirely misplaced.

The Examiner respectfully disagrees. Applicant, in fact, misunderstood the Objection to the Drawings. In 37 C.F.R. 1.83(b), the reference to an improvement of an old machine simply and broadly means to show the invention. That is, Applicant must show in the drawings the invention he intends to protect. Figures 5 and 10 are empty flowchart boxes that, by no means, show the disclosed method. Hence, the objection to the drawings stands.

Regarding claim 58, Applicant argues in page 8 that the claim 58 is a device claim, not a method claim.

The Examiner respectfully disagrees. Claim 58 clearly states "the method including". Furthermore, the claim includes no structural limitations, but only encompasses method steps. As such, it is unclear under 35 U.S.C. 112, second paragraph as explained above. Additionally, the Examiner points out the amendment to the claim by adding "hardware" overcomes the rejection under 35 U.S.C. 101 while positively changing the scope of the claim.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Yano et al (U.S. PGPub No. 2007/0132469)** discloses a second temperature control mechanism configured by providing a gas circulator circulating a gas.

**Leedy et al (U.S. Patent No. 6,838,896)** discloses a single gas tight system performing multi-functions.

**Littlebury et al (U.S. Patent NO. 4,698,931)** discloses a method of burning in integrated circuits on a semiconductor wafer.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA BENITEZ whose telephone number is (571)270-1435. The examiner can normally be reached on M-Th, 7:30-5:00; F, 7:30-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ha Nguyen can be reached on 571-272-1678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. B./  
Examiner, Art Unit 2829  
June 28, 2010

/Ha T. Nguyen/  
Supervisory Patent Examiner, Art Unit 2829